



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,303	11/22/2000	Michelle Q. Wang Baldonado	001508-3160	8448

7590 07/07/2006

NIXON PEABODY LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603

EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717,303

Applicant(s)

WANG BALDONADO ET AL.

Examiner

Djenane M. Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/11/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to amendment filed on 3/06/06 in which claims 1-50 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that “Knight does not teach or even suggest a need to spawn a new electronic forum”. However, Knight clearly teaches wherein “ tracking system that monitors and analyzes message content traffic from the subscribers and other source” and wherein the “information can also be used for ... adding modifying new groups and/ or classes for subscriber message data items (See col. 6, lines 40-53).

Furthermore, Applicant argues that Burnstein fails to teach matching users by the search strings they have provided, not by monitoring available documents in an information stream. However, Knight clearly teaches wherein “ the tracking system monitors and analyzes message content traffic from the subscribers....this routine preferably examines user query parameter, retrieved messages, user postings...” (See col. 6, lines 40-45).

In response to Applicant 's argument that the Office has not established any motivation, it would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the teaching of Burnstein in the claimed invention of Knight in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]) and to help build connections amongst people and teams within the larger organization (See page 1, paragraph [0003]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-11, 13-19, 21-28 and 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al.

a. As per claims 1, 9, 17 and 26, Knight et al teaches an online content provider system and method for compiling, creating and presenting content to users. Furthermore, Knight et al teaches an information monitoring device that monitors one or more electronic documents in an information stream associated with a first electronic forum, and compares information about the one or more electronic documents to one or more rules (See col. 9, lines 43-50 and col. 22, lines 35-44), Remark: Knight teaches first kind of extraction robot of the present invention periodically retrieve content from outside sources and online message board system. The content is extracted from these sources according to set of rules, filters or criteria specified by the online provider, and/ or gleaned from community based traffic monitoring); However, Knight et al fails

to teach forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users.

Burnstein et al teaches an automatic telephone, internet or intranet community formation. Furthermore, Burnstein et al teaches wherein an invention that contacts the currently searching and the previously searching users and asks them if they want to join a new community on the topic of the search string in the following manner. Initially the current searching user is contacted by the invention automatically. If that person indicates their interest in joining a community then the second action of the invention is to locate non-searching user(s) in the matched field and contacted them and ask if they want to join this community. If each answers in the affirmative, the invention automatically forms a new community and the users are entered as members of that community (See page 8, paragraph [0098]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate forum spawning device that queries a set of users when at least one of the at least one rules is satisfied and creates a new forum based on one or more replies from the set of users as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

b. As per claims 2, 10 and 18, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach an invitation determining device that determines which the set of users queried by the forum spawning device based on the one or more electronic documents.

Burnstein et al teaches an invitation determining device that determines the set of users queried by the forum spawning device based on the one or more electronic documents (See page 8, paragraph [0098]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate an invitation determining device that determines the set of users queried by the forum spawning device based on the one or more electronic documents as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

c. As per claims 3, 11, and 19, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al fails to teach wherein the forum spawning device queries the set of users to determine the need for the new forum.

Burnstein et al teaches wherein the forum spawning device queries the set of users to determine the need for the new forum (See page 8, paragraph [0098]).

I would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the forum spawning device queries the set of users to determine the need for the new forum as taught by Burnstein et al in the claimed invention of Knight et al in order to invite the match parties to join a frictionless and immediate electronic community if they so desire (See page 1, paragraph [0013]).

Art Unit: 2141

d. As per claims 5, 13 and 21, Knight et al teaches a subscriber maintenance device that associates the new electronic forum and at least one of the set of users (See col. 22, lines 35-44).

e. As per claims 6, 14 and 22, Knight et al in view of teaches the claimed invention as described above. Furthermore, Knight et al teaches an electronic document storage device that stores the one or more electronic documents (See col. 22, lines 35-44).

f. As per claims 7, 15 and 23, Knight et al teaches wherein the one or more electronic documents is at least one of- an electronic message; an e-mail-, a bulletin board posting; and an annotation to a shared document (See col. 9, lines 5-65).

g. As per claims 8, 16 and 24, Knight et al teaches wherein an information comparison is based on at least one of a rule-based model and a statistical-based model (col. 9, lines 25-65).

h. As per claim 25, Knight et al teaches the information storage media wherein an information comparison compares at least one of subject information; electronic document posting information; and electronic document tracking information (See col. 9).

i. As per claim 27-30, Knight et al teaches wherein the one or more electronic documents are one or more electronic messages (See col. 22).

Art Unit: 2141

j. As per claim 31-34, Knight et al teaches wherein the information stream comprises one or more electronic messages flowing between two or more of the users (See col. 5, lines 3-10).

k. As per claims 39, 42, 45 and 48, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the comparison is between newer messages and older messages to determine when a new topic of conversation has begun (See col. 24, lines 52-65).

k. As per claims 40, 43, 46 and 49 Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the information monitoring device detects whether the new topic of conversation is likely to generate additional messages (See col. 10, lines 5-10).

l. As per claims 41, 44, 47 and 50, Knight et al in view of Burnstein et al teaches the claimed invention as described above. Furthermore, Knight et al teaches wherein the forum spawning device further adds at least one of the set of users to the new electronic forum, and wherein the at least one of the set of users messages form both the first electronic forum and the new electronic forum (See col. 10)

5. Claims 4, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to

Art Unit: 2141

Burnstein et al as applied to claims 1, 9, 17 and 26 as applied above, and further in view of U.S.

Patent No. 6,651,086 to Manber et al.

a. As per claims 4, 12 and 20, Knight et al in view of Burnstein et al teaches the claimed invention as described above. However, Knight et al in view of Burnstein et al teaches a subscriber determining device that determines a set of subscribers based on the one or more electronic documents that satisfy the at least one or more rules.

Manber et al teaches a subscriber determining device that determines a set of subscribers based on the one or more electronic documents that satisfy at least one rule (See col. 4, lines 10-66).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a subscriber determining device that determines a set of subscribers based on the one or more electronic documents that satisfy at least one rule as taught by Manber et al in the claimed invention of Knight et al in view of Burnstein et al in order to dynamically create a conversation with other users (See col. 1, lines 43-45).

6. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,778,982 to Knight et al in view of U.S. Patent Application No. 2002/0032735 to Burnstein et al as applied to claims 1, 9, 17 and 26 as applied above, and further in view of U.S. Patent Application No. 2002/0059164 to Shtivelman.

Art Unit: 2141

a. As per claims 35-38, Knight et al Burnstein et al teaches the claimed invention as described above. However, Knight et al in view of Burnstein et al teaches wherein the one or more rules comprise at least one of the following: how long the current discussion forum has been in use; how many messages have been exchanged on the forum; whether there has been a suggestion to create a new discussion forum; whether a certain number of messages on a particular topic been received within a predetermined time period; whether the rate of messages exchanged on a particular topic been statistically greater than normal; or whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period.

Shtivelman teaches whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period (See page 5, paragraph [0052]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate whether a certain number of forum members exchanged messages on a particular topic within a predetermined time period as taught by Shtivelman in order to calculate new message load/responses parameters (See page 5, paragraph [0052]).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2141


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Djenane Bayard


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER